

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
JORDI A. ALBORNOZ	)	Group Art Unit: 3609
Serial No.: 10/759,966	)	
Filed: January 16, 2004	)	Examiner: C. Madamba
For: PROMPTED AUTOMATIC	)	
ONLINE PAYMENTS	)	
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**APPELLANT'S REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
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Sir:

In response to the Examiner's Answer dated February 24, 2009, Appellant hereby submits his reply brief in support of his appeal to the Board of Patent Appeals and Interferences of the Examiner's final rejection of claims 1-20 of the above-referenced application.

## **RESPONSE TO EXAMINER'S ARGUMENTS**

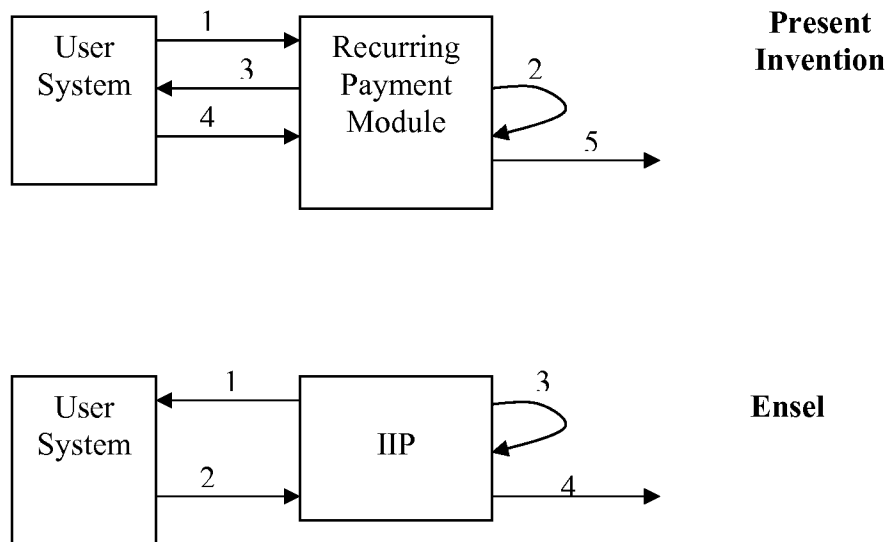
### **THE INDEPENDENT CLAIMS ARE PATENTABLE OVER ENSEL**

The Examiner has taken the position that independent claims 1-20 are unpatentable over Ensel et al. U.S. Patent No. 6,493,685. Appellant respectfully traverses this rejection because Ensel does not teach or suggest all of the elements and limitations of the claimed invention.

First, Ensel merely teaches a system in which a user can set reminders to receive a bill and instruct the system how to pay the bill. The bill itself can include a “pay” button or the user can formulate personal payment instructions within an email that is sent in reply to the email that includes the bill. See, e.g., Ensel at col. 8, lines 49-66.

The present invention, on the other hand, receives an automatic recurring online payment configuration from a user. This automatic recurring online payment configuration includes an amount and an interval that the system uses for executing multiple automatic recurring payments. The system receives this configuration information and then determines when an automatic recurring payment is about to be executed. When an automatic recurring payment is about to be executed, before making the payment the system sends a notification to the user to indicate to the user that the automatic recurring payment is about to be executed. The user then has the ability to respond to this notification, or not to respond. The system then takes an appropriate action to execute or not execute the automatic payment based on the user’s response.

Ensel only teaches that a user receives a bill and then instructs the system how to pay that bill. In the system of Ensel, once the user sends the payment instructions, the system never later sends a notification to the user that a payment is about to be executed so that the user can modify, confirm, or cancel the payment. The system of Ensel merely executes the payment at the pre-instructed time. The following diagrams illustrate these differences between the presently claimed invention and Ensel.



As shown in upper figure, at **1** the recurring payment module of the present invention receives, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a multiple automatic recurring payments. At **2**, the recurring payment module determines, based on the configuration information received from the user, if at least one automatic recurring payment is about to be executed. If so, at **3** the recurring payment module sends a notification to the user to indicate to the user that the automatic recurring payment is about to be executed. At **4**, the user either responds or does not respond to the notification, and at **5** the module determines whether or not to execute the automatic recurring online payment based on the user's response or lack of response to the notification that was sent at **3**. Therefore, the user is able to configure automatic recurring online payments, but is still notified before a payment is to be executed. This gives the user additional control over the automatic recurring payment, which the user had previously set up. In other words, after the user configures the system to execute the automatic recurring payment, the system notifies the user that the payment is to be executed before it is executed, and the user can respond (or choose not to respond) to this notification to confirm, modify, or cancel the payment.

As shown in lower figure, at **1** the system of Ensel merely notifies a user of a bill. At **2**, the user clicks a button in the email or sends a reply email to instruction the system how to pay the bill. At **3**, the system determines that a bill should be paid, and at **4** completes the payment. Thus, the system of Ensel merely notifies the user of the bill and never notifies the user that an automatic recurring payment is about to be executed. Thus, the user does not have additional control over an automatic recurring payment as in the present invention. After receiving the bill, once the user instructs the system of Ensel on how to pay the bill, the system of Ensel automatically pays the bill without ever first notifying the user that a payment is about to occur. Accordingly, the present invention distinguishes over Ensel for at least these reasons.

In the Examiner's Answer, the arguments on pages 12 and 13 (up to the third paragraph of page 13) merely describe how the system of Ensel performs a pre-authorized payment. The Examiner then goes on to state on page 13 of the Examiner's Answer that Ensel teaches:

"In one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the Email message, for example code which creates a "pay the bill" type button... Alternatively, the Email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then encrypted and sent back to the IIP [20] in a return Email message" [see at least col. 8, lines 57-66].

However, these "pay the bill" buttons of Ensel are embedded within a bill, and the payment instructions are sent in response to receiving a bill. In other words, in the system of Ensel, when the user selects the "pay the bill" button or sends payment instructions, the user is doing this for the first time in response to receiving a bill from the system. In contrast, in the present invention the user has already sent automatic recurring online payment configuration information to the system when the user receives the recited "notification". Therefore, the automatic payment is already set up in the when the system sends the notification to the user. This notification is sent to the user in response to the system determining that an automatic recurring payment, which the user has already configured, is about to be executed. The portion of Ensel that is cited merely teaches that the user sets up a pre-authorized payment for the first time. Accordingly, the present invention distinguishes over Ensel for at least these reasons as well.

The Examiner goes on to state on pages 13 and 14 of the Examiner's Answer that Ensel teaches:

The Enrollment database [205] contains all of the information relevant to the customers [80] of the biller [5]. Examples of the type of information included in Enrollment database [205] includes, but is not limited to: ...a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of the month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill...); ...reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 5 days late, no reminder...); payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." [see at least col. 10, lines 21-49].

"After having opportunity to review its bill, a customer [80] can initiate the payment process..." [see at least col. 17, lines 41-42].

The system of Ensel only uses these "reminder preferences" to remind a user of a bill. In the system of Ensel, reminders are generated based on user preferences to remind a user that a bill has not been opened. These teachings of Ensel clearly show that Ensel **only** teaches sending a bill notification. There is no teaching or suggestion that these reminders are associated with an automatic recurring payment.

The Examiner reasons on page 14 of the Examiner's Answer that:

It is apparent from the description in the above disclosures (i.e., "typically recurring bills", "enabling the customer to formulate payment instructions", "reminder preferences", "payment preferences", etc.), that Ensel is clearly directed towards notifying a customer or user that an automatic recurring payment is scheduled to be executed, the notification being sent to the user prior to the automatic recurring payment being executed. The limitation for the claim above as written, does not differentiate from the disclosure described above and is therefore interpreted broadly. As such, the rejection with regard to the above argument with regard to Ensel should be maintained accordingly.

However, the Examiner is taking Ensel's teaching of sending reminders for bills and improperly expanding the scope of this teaching to assert that Ensel teaches the recited limitation of "in response to determining that the one automatic recurring payment is to be executed, sending a

notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed".

The Examiner goes on to state on the bottom of page 14 and page 15 of the Examiner's Answer that:

"In one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the Email message, for example code which creates a "pay the bill" type button... Alternatively, the Email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then encrypted and sent back to the IIP [20] in a return Email message" [see at least col. 8, lines 57-66].

It is apparent based on the disclosure above, that the system, by informing or notifying the customer or user of a due payment and providing the customer with the option to respond through a response mechanism (e.g., "pay the bill" type button), is carrying out the function of determining whether it can go ahead and process the payment based on the response provided by the customer to its notification. As such, the limitation above as argued by Appellant, is clearly taught by the cited reference.

In addition, Ensel further recites:

The Enrollment database [205] contains all of the information relevant to the customers [80] of the biller [5]. Examples of the type of information included in Enrollment database [205] includes, but is not limited to: ...a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of the month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill...); ...reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 5 days late, no reminder...); ...Payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." [see at least col. 10, lines 21-49].

Clearly, based on the varying options or preferences provided to the customer pertaining to how or when he or she wants to be notified of a pending payment, the above disclosure illustrates the system carrying out the function of determining whether or not to execute or process a payment based on a response or instruction from the customer upon receipt of the notification. The limitation for the claim above as written, does not differentiate from the disclosure described above and is therefore interpreted broadly. As such, the rejection with regard to the above argument with regard to Ensel should be maintained accordingly.

However, the reasoning set forth above by the Examiner is misplaced because the "determination" of the present invention is based on the response or lack of response to the notification sent by the system. This "notification", as discussed above, is sent in response to the system determining that an automatic recurring payment, which the user has previously configured, is about to be executed. The information in the enrollment database of Ensel is merely the instructions that are sent to the system by the user when the user receives a bill. The determination made in the system of Ensel to perform a pre-authorized payment is based on the information sent to the system by the user when the user was notified of the bill, and is not in response to a user's response or lack of response to a notification sent by the system when an automatic recurring payment, which the user has previously configured, is about to be executed. Accordingly, the present invention distinguishes over Ensel for at least these reasons as well.

#### RESPONSE TO NEW GROUNDS OF REJECTION

The Examiner rejected claims 1-9 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 1 recites "receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments; determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration." Thus, claim 1 recites an "automatic recurring online payment configuration" and "automatic recurring payments". A physical information processing system such as a computer must perform "automatic" functions, such as the recited automatic payments. Accordingly, it is respectfully submitted that claims 1-9 are directed to statutory subject matter, and thus the rejections of claims 1-9 under 35 U.S.C. §101 should be withdrawn.

The Examiner also rejected claims 1-9 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that the claimed limitations do not adequately describe the structure of the device and that the body of the claims does not contain any limitations to indicate the structure of the device.

Claims 1-9 are method claims, not “system” or “apparatus” claim as indicated by the Examiner. Therefore,, the Examiner’s 35 U.S.C. §112, second paragraph, is improper. Furthermore, the failure to recite any specific structure makes the claims broad, not indefinite. A rejection under § 112 is proper only where one skilled in the art cannot understand what the claim covers.

In In re Miller, 441 F.2d 689, 169 USPQ 597 (C.C.P.A. 1971) (Rich, J.), the appellant claimed ultrafine particles of Teflon (or polytetrafluoroethylene) and a method for making the particles. The Patent Office Board of Appeals had affirmed a rejection for indefiniteness because the claim did not contain "the temperature of molding and the compositional characteristics of the molded material," which the Board believed would profoundly affect a flex strength limitation. Id., 169 USPQ at 599-600. The Court of Customs and Patent Appeals overruled the § 112 rejection, stating:

Even if it is not true, as appellant asserts, that it is generally understood in the art that omission of temperature from such a recitation indicates that room temperature is intended and the claims are therefore broader than they otherwise would be, breadth is not to be equated with indefiniteness, as we have said many times.

Id. at 600 (emphasis added).

The court noted that the first sentence of the second paragraph of § 112 "requires only that claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. . . . If those skilled in the art can tell whether any particular [Teflon] powder is or is not within the scope of a claim, the claim fulfills its purpose as a definition." Id. at 599 (internal citations and quotations omitted).

In the present application, claims 1-9 may not recite a specific structure, but these claims are not indefinite. One of ordinary skill in the art can tell whether a particular method is or is not within the scope of the pending claims. Under In re Miller, the omission of specific steps or elements makes the claims broader, but the omission does not make the claims indefinite. A rejection based on the scope of a claim must be done with prior art. Accordingly, Appellant submits that the rejections of claims 1-9 under 35 U.S.C. §112, second paragraph, should be withdrawn.



## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application and all of the pending claims are in condition for allowance. Reversal of the final rejection of claims 1-20 is respectfully requested.

Respectfully submitted,

Date: April 24, 2009

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